

## REMARKS

Claims 50 and 52-67 stand rejected under 35 USC §101 as not appropriately directed to statutory subject matter. Claims 50, 53 and 54 stand rejected under 35 USC §112, second paragraph as not being sufficiently definite. Claims 50, 52-67 stand rejected under 35 USC §103(a) as being unpatentable over US patent application publication 2002/0107809 (hereinafter Biddle) in view of US patent application publication No. 2003/0172034 (hereinafter Schneck) and further in view of US patent application publication No. 2002/0169725 (hereinafter Eng). Applicants respectfully requests reconsideration of the rejections in light of the foregoing amendment and the following remarks and further requests allowance of all claims.

Claims 1-49, 51 and 68-98 were previously cancelled. New claims 99-101 have been added. Accordingly, claims 50, 52-67, and 99-101 are pending.

No new issues are introduced in new claims 99 and 100 since these claims (in order to address the definiteness issues noted by the Examiner in connection with claims 53 and 54) simply recite a portion of the subject matter that was previously recited in claims 53 and 54. Claim 101 is is a "computer-readable media" claim also known as a "Beauregard claim". It is a claim to an article of manufacture embodied as a computer-readable medium. A "Beauregard Claim" is considered statutory at the USPTO as a product claim. (MPEP §2106.01). Accordingly, claim 101 is drawn to patent-eligible subject matter under § 101.

### Discussion of §101 rejections

Claim 1 is directed to an automation system for the graduated, usage-equivalent automatic licensing of multifunctional and/or expandable software products. See lines 1-2 of paragraph [0039] of the US patent application publication of the present invention (hereinafter disclosure). See also line 7 of paragraph [0047] of the disclosure. Applicant traverses the §101 rejections because the claimed invention (an automation system) is directed to statutory subject matter. For example, one skilled in the art will clearly recognize that an automation system is not an abstraction. Additionally, the claimed invention is clearly tied to statutory subject matter (e.g., a processor) and it solves a real world problem (e.g., allows to control an automated production process). For example, allows a user to schedule and pace production flows, manage and track materials and the like. See line 7 *et. seq.* of paragraph [0003] of the disclosure. In connection

with the claimed “processor”, Applicants respectfully note that changes made to an application supported by information disclosed in the specification are not considered new matter. See M.P.E.P. §2163.07(a). As the Examiner recognizes, aspects of the present invention are directed to software. Consequently one skilled in the art would readily appreciate that software cannot be used in vacuum but inherently requires a processor or a computer for operation. Accordingly, the instant application inherently discloses a processor to run the Manufacturing Execution System (MES), which the Examiner has expressly construed to be software. See page 2 of Advisory Action of December 16, 2009. In view of the foregoing considerations, the §101 rejection of claims 50 and 52-67 should be withdrawn.

Discussion of USC §112, second paragraph rejections.

M.P.E.P. 2173.02 cites approvingly case law that states that “the requirement to ‘distinctly’ claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles. Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.

The Examiner in a conclusory manner asserts that the phrase “automated production process” would be unclear to one skilled in the art. As evidentiary support against such an assertion, Applicant notes that according to the USPTO patent database at least US patent Nos. RE39,750; 6,910,996; 6,556,001 and 4,743,772 use the phrase “automated production process” in connection with their claims. For example, US patent No. 4,743,772, issued on May 10, 1988 recites in claim 1 “Method for determining the position of an object . . . in an automated production process”. Accordingly, it should be apparent that the phrase “automated production process” has a well-established and recognizable meaning, which would be readily discerned by one of ordinary skilled in the art.

In a similar fashion, the Examiner argues that the phrase “control solution” would be unclear and/or imprecise to one skilled in the art. For evidentiary support against this assertion, Applicant notes that according to the USPTO patent database about 128 US patents use the phrase “control solution” in connection with their claims. For example, claim 34 of US patent No. 5,594,858 issued on January 14, 1997 recites “a method for creating a process control

solution . . .” Accordingly, it should be apparent that the phrase “control solution” also has a well-established and recognizable meaning, which would be readily discerned by one skilled in the art. Accordingly, these bases of rejections should be withdrawn. Additionally, the issues noted in the Office Communication regarding claims 53 and 54 have been mooted since amended claims 53 and 54 no longer recite subject matter in alternative form. As noted above, this matter previously present in claims 53 and 54 is now recited in new claims 99 and 100. In view of the foregoing considerations, the §112, second paragraph rejections of claims 50, 53 and 54 should be withdrawn.

#### Discussion of §103 rejections

M.P.E.P. 2143.03 provides that to establish *prima facie* obviousness of a claimed invention, all the claims limitations must be taught or suggested by the prior art. All words in a claim must be considered for judging the patentability of the claim against the prior art. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending there from is nonobvious.

Claim 50 is directed to an automation system for the graduated, usage-equivalent automatic licensing of multifunctional and/or expandable software products. As amended, claim 50 in part recites an integration platform to integrate selected ones of a plurality of software products purveyed by a licensor to a systems integrator through the system. The integration platform is arranged by the systems integrator to form a Manufacturing Execution System (MES), which when executed by a processor is arranged to control an automated production process.

It is respectfully submitted that the combination of Biddle, Schneck and Eng fails to describe or suggest each of the structural and/or operational relationships of the claimed invention. For example, it is respectfully submitted that such a combination fails to describe or suggest “the integration platform being arranged by the systems integrator to form a Manufacturing Execution System (MES), which when executed by a processor is arranged to control an automated production process”. Additionally, such a combination fails to describe or suggest “wherein a control solution to be executed by the processor arranged to control the automated production process comprises at least one of the following: a first group of software products as integrated by the systems integrator in the integration platform without application-specific adaptors, and a second group of software products as integrated by the systems integrator

and further including application-specific adaptors, wherein the control solution is purveyed by the systems integrator to the end user through said system”. Moreover, such a combination fails to describe or suggest “the software products integrated in the integration platform and a number of application-specific adaptors used by the MES for providing the control solution to the automated production process”. The Office Communication (at line 1, page 6) cites paragraph [0134] of Biddle as relevant regarding the claimed invention. However, Applicant notes that one skilled in the art will fail to recognize that omnibus paragraph [0134] of Biddle provides any enabling disclosure to form a Manufacturing Execution System (MES) ), which when executed by a processor is arranged to control an automated production process, as set forth in the claimed invention. As described in M.P.E.P. §2141.01 B, it is not appropriate to sustain a §103 rejection “where the prior art gave only general guidance as to the particular form of the claimed invention” and much less with the boiler plate language of omnibus paragraph [0134] of Biddle. Accordingly, the combination of Biddle, Schneck and Eng fails to constitute *a prima facie* reference for appropriately sustaining a §103 rejection of the claimed invention. Therefore, this basis of rejection should be withdrawn.

#### Conclusion

It is respectfully submitted that each of the claims pending in this application recites patentable subject matter and it is further submitted that such claims comply with all statutory requirements and thus each of such claims should be allowed.

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The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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